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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/576,731	04/20/2006	Rikki Peter Alexander	07-1010-WO-US	8274

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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO, IL 60606

EXAMINER	
MORRIS, PATRICIA L	

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
300 S. WACKER DRIVE
32ND FLOOR
CHICAGO IL 60606

In re Application of :
Alexander et al.
Serial No.: 10/576,731 : Decision on Petition
Filed: April 20, 2006
Attorney Docket No.: **07-1010-WO-US** :

This letter is in response to the petition filed under 37 C.F.R. § 1.181 filed on March 19, 2010, to withdraw the final rejection of December 18, 2009.

BACKGROUND

A 3-way restriction requirement was mailed to applicants on March 3, 2009.

Applicants made an election to the restriction requirement on April 3, 2009.

The examiner mailed to applicants a non-final Office action on June 12, 2009. Claims 1, 4, 6 and 9 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. Claims 1, 4, 6 and 9 were rejected under 35 USC 112, first paragraph, as being non-enabling. Claims 11-25 were withdrawn from consideration. Claims 1, 4, 6 and 9 were indicated as allowable if amended to overcome the rejections under 35 USC 112. Claims 2, 3, 5, 7 and 8 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form.

On September 8, 2009, applicants submitted an amendment with remarks and amendments to the claims.

The examiner mailed to applicants a final Office action on December 18, 2009. Claim 1 was rejected under 35 USC 112, second paragraph, as being indefinite. Claim 1 was indicated as allowable if amended to overcome the rejections under 35 USC 112. Claims 2 - 9 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form.

On January 14, 2010, applicants submitted an after final amendment including claim amendments.

On January 26, 2010, the examiner mailed to applicants an advisory action indicating that the after final amendment would not be entered as applicant have failed to cancel the non-elected compounds or claims 11-25. The examiner noted the amendments to the claims overcame the 35 USC 112, second paragraph, rejection. On February 8, 2010, applicants submitted a second after final amendment including claims amendments and remarks.

On February 18, 2010, the examiner mailed to applicants an advisory action indicating that the second after final amendment would not be entered because applicants have failed to cancel the non-elected compounds.

On March 19, 2010, applicants submitted a third after final amendment with remarks.

On March 19, 2010, applicants concurrently submitted the petition currently under review.

DISCUSSION

The petition and file history have been carefully considered.

In the petition, applicants "respectfully submit that the search and examination procedure employed was inconsistent with Patent Office guidelines and deprived the applicants of their right to a full search of the claims. Therefore, the final rejection should be withdrawn and the claims searched to their full scope, with respect to the scope of the claim element R^2. Having found no prior art that invalidated the claim as limited even to what the applicants submit is an overly narrow construction of R^2 based on the provisionally elected species, the search should have been expanded to encompass the full scope of R^2."

Specifically, applicants argue the proper procedure for examining Markush claims is set forth in MPEP 803.02, a search of a Markush claim (which may include independent and distinct inventions) is to begin with the elected species and, if the species is allowable over the prior art, expanded to the full scope of the claims allowable over the prior art. The search may be stopped short of the full scope only if prior art is found that renders the claims unpatentable as anticipated or obvious; rejections under 35 USC § 112 are not a proper basis for limiting the search to the elected species. This is consistent with the policy of compact prosecution, which requires simultaneous examination of the claims as to all bases of patentability.

Because an improper search and examination procedure was employed and the applicants denied the search to which they were entitled, the applicants respectfully submit that the Office should withdraw the final rejection and search the claims to the scope permitted by the prior art, up to the full scope of the claims. Should prior art be identified, a non-final action would be

appropriate to permit the applicants an opportunity to amend the claims and/or argue in favor of patentability. If the prior art rejection is thereby overcome, the search should be expanded once again, as is consistent with the example provided in MPEP § 803.02.

Applicants' arguments have been accorded careful consideration and are persuasive. Accordingly, prosecution will be reopened.

DECISION

The petition is **GRANTED**.

The Office action mailed December 18, 2009 is hereby vacated to the extent that it was made "final" and the Office action is now considered to be a non-final Office action. The after final amendments of January 14, 2010, February 8, 2010 and March 19, 2010 will also be entered. This application will be forwarded to the examiner to take an action consistent with the decision herein.

The application will be forwarded to the examiner for preparation of a action(s) wherein proper search and examination procedures are followed.

Should there be any questions about this decision, please contact Special Program Examiner Marianne Seidel, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.

Remy Yucel
Acting Director, Technology Center 1600